IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventors:	Kevin E. Laracey; Krishna A. Canekeratne; Edward J. Morgan; Brian C. Barnes; Ishan Birchett		
Assignee:	Siebel Systems, Inc.		
Title:	ELECTRONIC BILL PRESENTMENT AND PAYMENT		
Application No.:	09/602,697	Filing Date:	June 24, 2000
Examiner:	Richard C. Weisberger	Group Art Unit:	3693
Docket No.:	OIC0055US	Confirmation No.:	1482

Austin, Texas
May 18, 2009

MAIL STOP AF
COMMISSIONER FOR PATENTS
P. O. BOX 1450
ALEXANDRIA, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicant hereby requests review of the Final Office Action mailed January 16, 2009 (the "Final Office Action") and the Advisory Action dated May 11, 2009 (the "Advisory Action") in the above-identified application. The Final Office Action sets a three-month shortened statutory period for reply. This Request is being filed concurrently with a Notice of Appeal and a petition for a one month extension of time that extends the period for reply to Monday, May 18, 2009 to file this Notice of Appeal since the extended due date of May 16, 2009 falls on a Saturday.

Claims 1-11 are pending. These claims stand rejected under 35 U.S.C. §103(a) as being unpatentable over Gillespie, Market Overview: Electronic Presentation and Payment (Gillespie). Gillespie is dated November 28, 2001.

Section 103 forbids issuance of a patent when the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. *KSR International Company v. Teleflex, Inc.*, 127 Supreme Court 1727, 1734 (2007).

As reiterated by the Supreme Court in KSR, the framework for the objective analysis for determining obviousness under 35 U.S.C. §103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1 (1966). Obviousness is a question of law based on underlying factual inquiries including the differences between the claimed invention and the prior art. See MPEP 2141. Before answering Graham's "content" inquiry, it must be known whether a patent or publication is in the prior art under 35 U.S.C. §102. *Panduit Corp. v. Dennison Manufacturing Co.*, 810 Fed.2nd 1561 (Fed. Cir.) cert. denied, 481 U.S. 1052 (1987).

The instant application predates Gillespie, which is dated November 28, 2001. Gillespie is not prior art under 35 U.S.C. §102. As such, the pending claims cannot be rejected as being obvious over Gillespie.

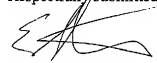
The key to supporting any rejection under 35 U.S.C. §103 is the clear articulation of the reasons why the claimed invention would have been obvious. The Supreme Court in KSR noted that the analysis supporting a rejection under 35 U.S.C. §103 should be made explicit. The Federal Circuit has stated that "Rejections on obviousness cannot be sustained with mere conclusory statements; instead there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, 441 Fed.3rd 977, 988 (Fed. Cir. 2006).

In an Advisory Action dated April 16, 2009, the Examiner maintains his prior position that Gillespie is clear that the claim method and underlying technology were enabling prior to the filing date of the instant application, and that the basis for this position is that the reference is an industry trade document covering the state of the industry. This statement seems to ignore the fact that the instant application claims benefit to U.S. Provisional Applications 60/203,411 (May 11, 2000), 60/184,879 (February 25, 2000), and 60/140,873 (June 24, 1999). Importantly, the Examiner's position is an unsupported conclusion.

In light of the foregoing, Applicants submit the Final Office has failed to establish a *prima facie* basis for rejecting the independent claims under 35 U.S.C. §103.

For at least the forgoing reasons, claims 1-11 and 25-33 and all claims dependent therefrom are also allowable.

Respectfully submitted,



Eric A. Stephenson
Attorney for Applicants
Reg. No. 38,321
Telephone: (512) 439-5093
Facsimile: (512) 439-5099